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In re Application of
Kenneth N. Bates
Application No. 09/628,942
Filed: July 28, 2000
Title of Invention:
ACOUSTIC WAVE IMAGING
APPARATUS AND IMAGING

OFFICE OF PETITIONS
ON PETITION

This is a decision on the Renewed Petition to Revive Under 37 CFR 1.137(a), filed August 1, 2003.

The petition is **DISMISSED**.

Applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.37"; should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor, AND BE ADDRESSED TO petitions Attorney Derek L. Woods. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

Background

The application became abandoned for failure to timely and properly reply to the final Office action, mailed October 2, 2002, which set a shortened statutory period of three months for reply. Applicant filed an amendment in response to the final Office action on December 30, 2002. That response, however, was deemed not to place the application in condition for allowance. Applicant was so advised in an Advisory Action, mailed January 6, 2003. Applicant filed a Request for Reconsideration, along with a Request for a one (1) month extension of time to reply to the final Office action. In response to the Request for Reconsideration, a second Advisory Action was mailed on February 26, 2003. That Advisory Action informed Applicant that claims 24 - 28 were allowed, but the amendment was not in compliance with 37 CFR 1.173(c). Applicant filed a response to the

February 26, 2003 Advisory Action; however, that response failed to place the application in condition for allowance because Applicant still had not complied with 37 CFR 1.173. Applicant was so notified in a third Advisory Action, mailed April 16, 2003. A Notice of Abandonment was mailed May 5, 2003.

Applicant filed a petition to revive the application based upon unavoidable abandonment on June 6, 2003. Applicant argued in the petition that the delay was unavoidable in part because he was unsure of the Examiner's request, and in part because this Office failed, for two months, to recognize the claims as allowable. *Original Petition* at p.2.

The petition was dismissed in a Decision mailed June 30, 2003, for failing to meet the requirements of a grantable petition under 37 CFR 1.137(a). The Decision dismissing the petition informed Applicant that it was Applicant's responsibility in the first instance to file a complete and proper reply, and that a delay was not unavoidable when Applicant permits the period for reply to expire while awaiting a reply from this Office. Moreover, Applicant was advised that a delay cause by Applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the Manual for Patent Examining Procedure ("MPEP") is not rendered unavoidable due to (1) Applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the Applicant of any deficiency in sufficient time to permit the Applicant to take corrective action. *Decision* at p.3-4.

Applicable Law

Petition under 37 CFR 1.137(a) for unavoidable abandonment

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a notice of appeal and the requisite fee; a continuing application; an amendment or request for reconsideration which *prima facie* places the application in condition for allowance, or a first or second submission under 37 CFR 1.129(a) if the application has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 USC 120, 121 and 365(c); (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable

petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks item (3).

The instant Renewed Petition

Applicant files the instant Renewed Petition and avers that 37 CFR 1.173, "as written or as applied by the Examiner, are not sufficiently clear as to permit a practitioner to respond in a 'certain' manner." *Renewed Petition* at p.1. Applicant asserts that "[i]t is this lack of clarity in the regulations as written or as applied that has le[d] to abandonment of the above-identified application." *Renewed Petition* at p.2.

Applicant's assertions are not well taken. Applicant is charged, as a Registered Practitioner, with knowledge and understanding of the patent rules. See *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985). Applicant now asserts that it is a lack of clarity in the regulations as written or as applied that led to the abandonment of the application. That the rules are unclear as to Applicant does not amount to unavoidable delay. As iterated in the Decision mailed June 30, 2003, Applicant's misunderstanding of the rules, and this Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action, do not amount to unavoidable delay. See *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985). Furthermore, Applicant, with the assistance of the Examiner, was able to comply with the 37 CFR 1.173. *Original Petition* at p.2. Applicant stated in his original petition that part of the delay was due to a "good faith misunderstanding as to the interpretation of § 1.173 which the Examiner and the Applicant... eventually achiev[ed]...." *Original Petition* at p.2. For Applicant to initially argue that there was a good faith misunderstanding, and to now argue that the rule is not clear, is an argument that is not well taken.

Conclusion

Accordingly, the application remains abandoned.

A Decision on the petition under 37 CFR 1.137(b) follows under separate cover.


Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries concerning this matter should be directed to
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